

## REMARKS

Reconsideration and the timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

In the Office Action dated April 25, 2006, the Examiner rejected claims 8 and 20, under 35 U.S.C. §112, ¶2, as allegedly being indefinite; rejected claims 1-2 and 4-8, under 35 U.S.C. §102(e), as allegedly being anticipated by Kojima '466 (U.S. Patent No. 6,881,466); rejected claims 1-2 and 4-7, under 35 U.S.C. §102(e), as allegedly being anticipated by Inase '495 (U.S. Patent Pub. No. 2002/0168495); rejected claims 1-2, under 35 U.S.C. §102(e), as allegedly being anticipated by Nishihara '473 (U.S. Patent Pub. No. 2003/0180473); rejected claims 1-2 and 4-8, under 35 U.S.C. §102(e), as allegedly being anticipated by Kojima '069 (U.S. Patent Pub. No. 2004/0023069); rejected claims 1-5, under 35 U.S.C. §102(e), as allegedly being anticipated by Oomachi '908 (U.S. Patent Pub. No. 2004/0076908); rejected claims 1-5, 9-17, and 21, under U.S.C. §103(a), as allegedly being unpatentable over Oomachi '908; rejected claims 1-2, under U.S.C. §103(a), as allegedly being unpatentable over Kitaura '681 (U.S. Patent No. 7,008,681); rejected claims 1-7, 9-19, and 21, under U.S.C. §103(a), as allegedly being unpatentable over Shinotsuka '418 (U.S. Patent Pub. No. 2004/0001418) in view of Kasami '221 (U.S. Patent No. 5,786,221) and Kitaura '681; rejected claims 1-21, under U.S.C. §103(a), as allegedly being unpatentable over Shinotsuka '418 in view of Kasami '221, Kitaura '681, and Kojima '466; and rejected claims 1-5, 9-17, and 21, under non-statutory double patenting, as allegedly being unpatentable over claims 1-18 of Kitaura '681.

By this Amendment, claims 1, 4, 5, 8, and 20 have been amended to provide a clearer presentation of the claimed subject matter and claims 2-3 have been cancelled without prejudice or disclaimer. Applicants submit that no new matter has been introduced.

Applicants further submit that the changes to claims 8 and 20, render the indefiniteness rejections moot. That is, the changes to these claims are based on the embodiments disclosed in the written description. (See, Original Specification: page 21, lines 1-10; page 58, lines 1 and 26). Accordingly, the immediate withdrawal of the §112, ¶2 rejections of claims 8 and 20 is respectfully requested.

Applicant respectfully traverses the prior art rejections, under 35 U.S.C. §§102(e), 103(a), for the following reasons:

I. Prior Art Rejections Under §§102(e), 103(a).

As a preliminary matter, Applicants remind the Examiner that, as noted in M.P.E.P. §2136.05, a rejection based on 35 U.S.C. §102(e) may be overcome if the *filing date of a reference can be antedated by applicant's earlier foreign priority application* or provisional application provided that 35 U.S.C. §119 is met and the foreign application or provisional application "supports" (*i.e.*, conforms to 35 U.S.C. §112, ¶1 requirements) all the claims of the corresponding U.S. application. (*See, In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989)).

With this said, Applicants are filing, concurrently herewith, certified English translations of JP 2002-339437, filed on November 22, 2002, and JP 2002-342896, filed on November 26, 2002, of which the present application claims foreign priority, under 35 U.S.C. §119. Applicants submit that the certified English translations of priority applications JP '437 and JP '896 fully comply with the requirements of 35 U.S.C. §112, ¶1 and that these priority applications clearly antedate each of the following asserted references:

- (a) Kojima '466
- (b) Nishihara '473
- (c) Oomachi '908
- (d) Kitaura '681
- (e) Shinotsuka '418

Accordingly, the §102(e) rejections and the associated §103(a) rejections, based on the references listed above, are effectively rendered moot and the immediate withdrawal of these rejections is respectfully requested.

Regarding the remaining prior art rejections, Applicants point out that, as indicated above, amended independent claim 1 now incorporates subject matter previously recited in dependent claims 2-3. In so doing, independent claim 1 positively recites a first interference film formed on the transparent substrate, a second interference film, and a reflection film formed on the second interference film, wherein the lower and upper interface films are formed of hafnium oxide, or a mixture of hafnium oxide and at least one oxide selected from the group consisting of cerium oxide, titanium oxide and zirconium oxide.

In contrast to the Examiner's assertions, none of the remaining asserted references, namely Inase '495 and Kasami '221, whether taken alone or in reasonable combination, teach each and every element of claim 1, including the features identified above.

For at least these reasons, Applicants submit that claim 1 is patentable over the remaining references. In addition, because claims 4-8 depend from claim 1, claims 4-8 are patentable at least by virtue of dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the prior art rejections of claims 1 and 4-8 is respectfully requested.

Moreover, the prior art rejections of independent claim 9 have been rendered moot by the antedating English translations of priority applications, submitted concurrently herewith. As such, claim 9 is patentable and dependent claims 10-21 are patentable at least by virtue of dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the prior art rejections of claims 9-21 is respectfully requested.

## II. Non-Statutory Double Patenting.

Applicants remind the Examiner that, before consideration can be given to the issue of double patenting, there must be *some common relationship of inventorship and/or ownership* of two or more patents or applications. (See, M.P.E.P. §804).

With this said, Applicants point out that the Kitaura '681 reference is assigned to Matsushita Electric Industrial Co. – not to the assignee of the present application. Nor is there a single inventor that is common to both, the Kitaura '681 reference and the present application. Accordingly, the non-statutory double-patenting rejection has been issued in error and the immediate withdrawal of this rejection is respectfully requested.

## III. Conclusion.

All matters having been addressed and in view of the foregoing, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicants' counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains in issue in which the Examiner

feels may be best resolved through a personal or telephone interview, please contact the Undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number 03-3975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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